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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MEISLAHN, DOUGLAS J	

ART UNIT	PAPER NUMBER
2137	20

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/226,577	CHANEY, JACK	
	Examiner	Art Unit	
	Douglas J. Meislahn	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2003 and 29 December 2003*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8 and 10-41* is/are pending in the application.

4a) Of the above claim(s) *15-41* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-8 and 10-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 03 July 2003 and the response to the election filed 29 December 2003, the former of which amended claims 20 and 28 while the latter elected claims 1-14.

Claim Objections

2. Claims 3, 4, 10, and 11 are objected to because of the following informalities: they use the language "further comprising the step of transmitting" or "further comprising a transmitter"; in both cases, the parent claims have been amended to include these features. As the dependent claims now read, the method would include two steps of transmitting and the system two distinct transmitters. The examiner believes that applicant intends for the dependent claims to limit the parent claims' step of transmitting or transmitter and has interpreted the claims thusly. Appropriate correction is required.

Response to Arguments

3. Applicant's arguments filed 03 July 2003 have been fully considered but they are not persuasive. The arguments with respect to claims 15-41 are unpersuasive because the claims are non-elected.

4. In response to applicant's argument that Berson is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Berson relates to protecting a digital signal from illicit use.

5. Applicant's opinion that Berson does not teach the last clause of claim 1 is based on a misreading of the reference; applicant has interpreted the cited section of Berson to teach transmitting an encryption key E_i and an encoded decryption key $X[D_i]$. The cited section specifically teaches sending $E_i[M]$ and $X[D_i]$. The first of these is not the actual encryption key, as stated by applicant, but rather the data M encrypted by E_i. This correct reading of the cited section makes clear that Berson shows transmitting a scrambled signal and data signal used to protect that signal to a receiver.

6. Applicant's mention of Girod failing to include all of the limitations of the last clause is consistent with the rejection, which corrects this deficiency through the inclusion of Berson.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-8, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girod et al. in view of Berson et al. (5742685).

In their abstract, Girod et al. teach watermarking a compressed signal. In figure 1, the lower input is a digital signal, which is compressed by element 10 (see lines 47-

62 of column 3 and line 60 of column 4 through line 21 of column 5 for a description of figure 1), thereby reading on clause a) of the claims. Element 26 watermarks the compressed signal; the watermark is inserted using a frequency spreading signal, which meets applicant's data signal representing copy protection data, while the watermarking operations read on the copy protection function. In the abstract, Girod et al. say that encryption/decryption capabilities can be included but does not specify how or where. Claim 8 and figure 4 make it clear that encryption is applied after compression and watermarking. Encryption is a type of scrambling and so clause c) is met. The reversal of these steps is implied by figures 1 and 2c. While Girod et al. specifically disclose decoding preceding removal of the watermark, these steps are interchangeable, as is understood from lines 7-10 of column 5. This is part of the benefit of Girod et al.'s watermarking method. As described at the top of column 9, removal of the watermark requires the sequence that was used to embed the watermark. Girod et al. do not indicate how the receiver acquires the sequence. In lines 9-12 of column 4, Berson et al. teach appending a decryption key to a cryptogram in order to facilitate recovery of the encrypted information. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to facilitate removal of the watermark in Girod et al. by including the frequency spreading signal with the transmitted data as taught by Berson et al.

Claims 3 and 4 are rendered obvious by the cited section of Berson et al. The elements of claims 5 and 6 are rendered obvious by the steps described by Girod et al.

The steps of claim 7 are met for reasons similar to claim 5. Claims 8 and 10-14 are a system for the method of claims 1 and 3-7 and are rejected for the same reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas J. Meislahn
Examiner
Art Unit 2137

DJM